

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1, 2, 4, 7, 9, 12, 18, 19, 21 and 23-25 are pending. Claims 1, 2 and 24 are independent claims. Claims 1, 2, 4, 7, 9, 18, 19 and 21 have been amended. Claims 24 and 25 have been added. Claims 3, 5, 6, 8, 10, 11, 13-17, 20 and 22 have been canceled. The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and Remarks as set forth hereinbelow.

INTERVIEW

Applicants thank Examiner Strimbu for his time and courtesy extended to the Applicants' representative during the telephone interview on December 5, 2003, where in it was agreed that the Examiner would consider the pending claims for allowability based on the amendments to the claims and the following remarks.

Objection to the Drawings

The Examiner has approved the proposed drawing changes submitted with the Applicant's Amendment on July 16, 2003. Accordingly, replacement sheets including the changes to the drawings as approved by the Examiner are attached hereto. It is

respectfully requested that the Examiner enter the replacement drawings into the official record and indicate approval of the replacement sheets in the next Office Action.

**Claim Rejections**

Claim 4 is objected to as lacking proper punctuation. This rejection is respectfully traversed.

Claims 1, 2, 4, 6, 7, 9, 11, 12, 16-19, 21, and 23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

While the claims have been amended, Applicants do not concede that the Office Action's statutory rejections are proper. The amendments are understood to not narrow the scope of the claimed embodiments nor have they been made for reasons related to patentability. Rather, the amendments are made to clarify the claimed embodiments. Thus, in future construction or interpretation, the amended claims should be entitled to a full range of equivalents.

**Rejection Under 35 U.S.C. § 102**

Claims 1, 6, 16, and 17 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,014,464 to Dupuy et al.

Additionally, claims 2, 4, 7, and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by 5,217,786 to Keys. These rejections are respectfully traversed. It is respectfully submitted that these claims are not anticipated by the prior art cited by the Examiner.

As set forth in Section 2131 of the MPEP Original Eighth Edition, August, 2001, page 2100-68:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. Of California, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." Richardson v. Suzuki Motor Co., 868 F2d 1226, 1236, 9 USQP2d 1913, 1920 (Fed. Cir. 1989).

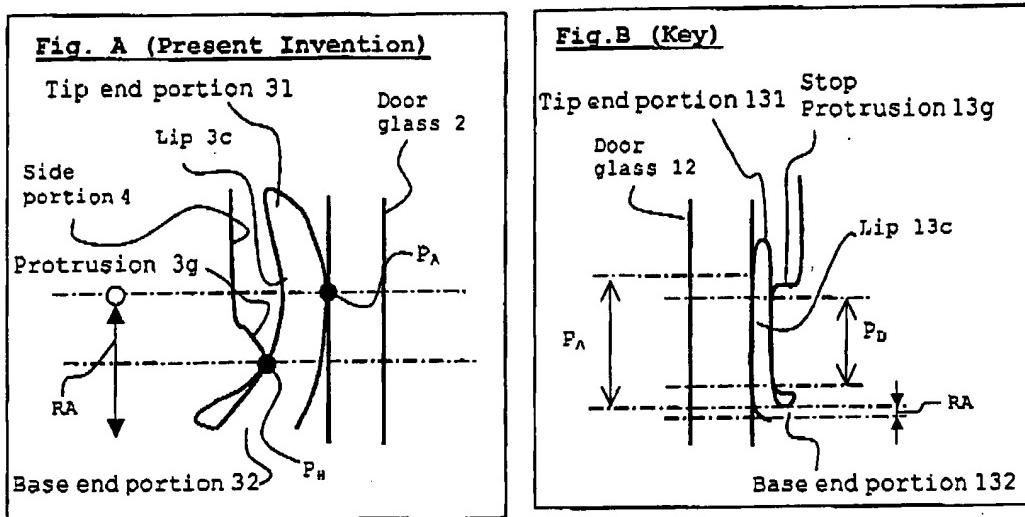
With regard to amended claim 1, concerning about setting a concave notch portion depth equal to or less than 0.5 mm, the Examiner stated that one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. However, the Examiner's rejection is not acceptable for the following reasons:

(a) A concave notch portion is for reducing of a resistance force which door glass receives from the lip on its moving. And the resistance force gets lower as the notch is deeper. Therefore, it is general that the concave notch portion depth is set to be deeper than specific value. Against that, according to the present

invention, directing a view point to the fact that area of part of lip pressed against a side portion of door glass run body (hereinafter this area is called "pressed area") and rattle noise get smaller as notch depth gets shallower, smooth moving of the door glass and efficient reducing of the rattle noise are realized at the same time by setting the notch depth equal or below 0.5 mm.

(b) Based on a background that flush surface of car body is progressing, it is general that the concave notch portion depth is set to be as deep as possible in order that the resistance force does not get higher even if a door glass is arranged near the outside of the cabin. According to the present invention, a more suitable set range of the concave notch portion depth is clarified as a result of an investigation about a relationship among the pressed area, rattle noise and the concave notch portion depth.

With regard to amended claim 2, the following figures, i.e., Fig. A and Fig. B, depict the present invention and the invention of the Key reference, respectively:



In the present invention, according to claim 2, at least one of side portions includes a protrusion facing the lip extending from said at least one side portion.

The explanation about the protrusion will be described using an example shown in the above Fig. A. In this example, a protrusion 3g is included with a side portion 4 from which a lip 3c extends. A height of the protrusion 3g is set so that, when the lip 3c is pressed against the protrusion 3g, a tip end portion 31 of lip 3c does not contact with the side portion 4. In addition, a tip end of the protrusion 3g is disposed in a region RA. The

region RA is between a part  $P_A$  of the lip 3c, which contacts with the door glass 2 and a base end portion 32 of the lip 3c. And region RA does not include said part  $P_A$  of the lip 3c.

In comparison, as shown in Fig. B, in Key, a tip portion of a stop protrusion 13g is not in the Region RA, which is between a part  $P_A$  of the lip 13c which contact with the door glass 12 and a base end portion 132 of the lip 13c and not including said part  $P_A$  of the lip 13c.

Such a difference, the present invention has the advantage as follows compared to Key.

That is, in the present invention, a part  $P_B$  of the lip 3c which contact with the protrusion 3g is out of the part  $P_A$ . In consequence that, force from the vibrating door glass 2 to the protrusion 3g is reduced by the elasticity of the lip 3c when the lip 3c is pressed against the protrusion 3g by door glass vibration, the collision of the lip 3c with the protrusion 3g is reduced. Therefore, door glass 2 rattling noise can be reduced.

On the other hand, in Key, a part  $P_B$  of the lip 13c which contact with the stop protrusion 13g and the  $P_A$  wrap over. In consequence that, collision between the vibrating door glass 12 and the stop protrusion 13g through the lip 13c is a head-on and big rattling noise generates.

It is respectfully submitted that the prior art cited by the Examiner does not set forth each and every element as defined in the amended claims. Thus, the Examiner's rejection based on 35 USC 102 has been obviated.

**Rejection Under 35 U.S.C. § 103**

Claims 11 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dupuy et al. or Keys--the Examiner refers to Keys in the rejection statement but the discussion refers to Dupuy et al. only. Also, claims 12, 19, 21, and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Keys. This rejection is respectfully traversed.

Applicants respectfully submit that when one recognizes that a problem exists in the prior art, and thereafter, solves that problem, that the Applicants are entitled to a patent when the prior art fails to teach or suggest the solution thereof.

For example, as stated by Judge Johnson in In re Shaffer, 108 USPQ 326 (CCPA 1956):

"It is too well settled for citation that references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done ... (citation of cases) .... Furthermore, when references are combined to negate patentability,

it should also be considered whether one skilled in the art with the references before him could have made the combination of elements claimed without the exercise of invention ... (citation of cases) .... The foregoing cases, in our opinion, stand for the proposition that it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined."

It is respectfully submitted that a rejection under 35 U.S.C. § 103 is not proper unless the prior art provides a teaching for combining the references so as to render obvious the subject matter set forth in the claims. As set forth in Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315 (Fed. Cir. 1988) the Court stated:

"The problem confronted by the Inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem ...."

In the specific situation presented to the Examiner, the Examiner acknowledges that Dupuy et al. fails to disclose "the particular depth of the notch portion" as set forth in claim 1. The disclosure set forth in Keys does not overcome the deficiencies of Dupuy et al. There is no teaching or motivation to modify the configuration.

Claims 4, 7, 9, 12, 18, 19, 21, and 23 depend directly or indirectly from independent claims 1 and 2. Therefore, these dependent claims are also distinguishable over the combination of

Dupuy et al. or Keys for at least the reasons stated with respect to the independent claims.

Applicant respectfully requests withdrawal of the rejection of claim 1, 2, 4, 7, 9, 12, 18, 19, 21, and 23 as well as new claims 24 and 25 under 35 U.S.C. §103 based on Dupuy et al. or Keys.

CONCLUSION

In view of the response above, no further comments are considered necessary.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Daniel K. Dorsey (Reg. No. 32,520) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 CFR 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

Appl. No. 09/899,095

Reply to Office Action of September 8, 2003

Atty. Docket: 1602-0173P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Replacement Sheets of Formal Drawings